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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10014078-1

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on Dec 21st 2005

Signature

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Typed or printed name

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Application Number

09/915978

Filed

Jul 25, 2001

First Named Inventor

Gabriel Begged-Dov

Art Unit

3725

Examiner

Miller, Bena B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 _____

21-Dec-05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Gabriel Beged-Dov) Attorney
Serial No: 09/915,978) Docket Number: 10014078-1
Filed: July 25, 2001) Confirmation Number: 8178
Title: Gyroscopically Stabilized) Group Art Unit: 3725
 Throwable Implement.) Examiner: Bena Miller

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above identified application. No amendments are filed with this request. This request is filed with a Pre-Appeal Brief Request for Review and a Notice of Appeal.

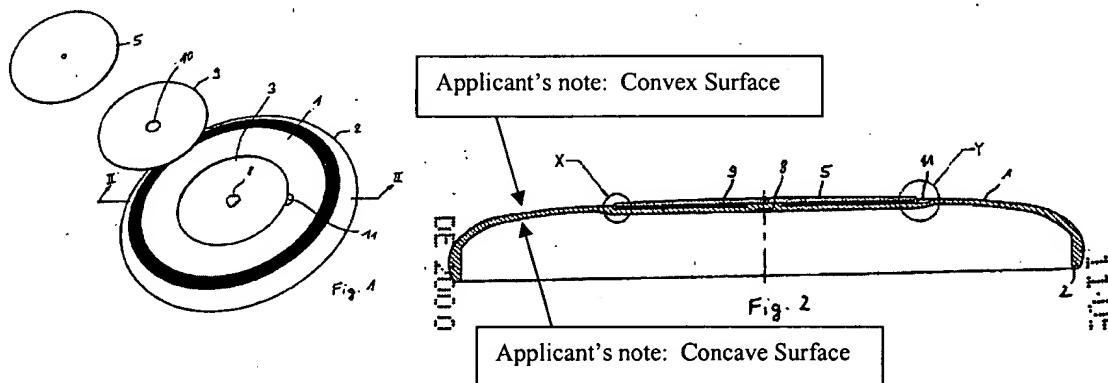
REMARKS SUPPORTING REQUEST FOR REVIEW

Overview: Applicant's claimed invention covers a gyroscopically stabilized throwable implement that, among other claimed elements, includes a "plurality of flexible fingers disposed in a first circle on said second surface and protruding for a predetermined distance away from said second surface". The essential issue in this pre-appeal brief is whether any of the references cited by Examiner teach, suggest, or mention a throwable implement having a convex first surface and an essentially concave second surface with a plurality of flexible fingers disposed on the concave second surface. Applicant believes that none of the references cited teach, suggest, or mention the plurality of flexible fingers on the essentially concave second surface.

Applicant's claim 1 has been twice rejected under U.S.C. 102(b) as being anticipated by Adoma.

Issue #1: As stated in the MPEP, "to anticipate a claim, the reference must teach **every** element of the claim." Applicant believes the claim element "**protruding for a predetermined distance away from said second surface**" in independent claim 1 is not included in Examiner's analysis. In Examiner's office action (OA) of 4/27/2004, top of page 4, Examiner states "Adoma teaches in the figures most of the elements of the claimed invention" under a 35 U.S.C. 103(a) rejection, but Examiner does not note the above claimed element. In Examiner's OA of 3/2/2005 in the middle of page 2, Examiner changed position without explaining how Adoma could be used

as a rejection to anticipate claim 1, having indicated previously (4/27/2004) Adoma only teaches “**most** of the elements”. “Most of the elements” is not “every element” therefore, Examiner rejected claim 1 under 35 U.S.C. 102(b) failing to note the above claimed element. In Examiner’s final OA of 9/26/2005 on page 2 Examiner again fails to note the above claimed element by reasserting the 102(b) rejection without any clarification over the previous OA. In Applicant’s response of 8/26/2004, page 2 line 15, to Examiner’s OA of 4/27/2004 for Examiner’s 103(a) rejection, Applicant’s response states “Examiner acknowledges that Adoma is an insufficient reference and therefore must find the missing elements for Applicant’s invention in the teaching of McClung.” In Applicant’s response of 6/1/2005, near the bottom of page 5, to Examiner’s OA of 3/2/2005 where Examiner changed positions and rejected Applicant’s claimed invention under 102(b) using Adoma, Applicant’s response states that claim 1 includes the element “protruding for a predetermined distance away from said second surface”. Applicant believes that Examiner has failed to recognize that Adoma lacks the claimed element “protruding for a predetermined distance away from said second surface.” Thus, Applicant asserts that clearly Adoma does not disclose, teach, or suggest **protruding for a predetermined distance away from said second surface**,” see Figs. 1 & 2 of Adoma below. Therefore, Applicant believes for this reason alone, Adoma does not anticipate Applicant’s claimed invention.



Issue #2: In addition, the claimed element “**a plurality of flexible fingers disposed in a first circle on said second surface**” of Applicant’s independent claim 1 is not taught by Adoma. Please note that the second surface is the concave surface in Applicant’s claim and in the above Figures, Adoma clearly does not show any structure on the concave second surface.

In the Examiner's OA of 3/2/2005, middle of page 2, Examiner states "Adoma teaches in the figures throwable implement comprising a disk-shaped body (fig.1), a convex first surface and concave second surface (fig1) and a plurality of flexible fingers (8) disposed in a first circle on the second surface and the first circle having a center essentially concentric with an axis of rotation of the implement." This verbatim argument is also maintained in the Examiner's final OA of 9/26/2005, top of page 2, despite Applicant's response on 6/1/2005 in the middle of page 6 stating "Thus, Adoma discloses a throwing disk having a recessed part, formed in the top or convex surface of the disk that holds a compact disk and is covered with a removable cover. Adoma does not disclose, teach, or suggest a throwable implement having a plurality of flexible fingers disposed in a first circle on the second surface (i.e. essentially concave surface) and that protrude away from the second surface." Applicant believes that the Examiner has failed to recognize that Adoma not only lacks teaching the above claimed element a **plurality of flexible fingers**, but that Adoma also lacks teaching the above claimed element **on the second surface**. Thus, Applicant asserts that clearly Adoma, by itself, is an insufficient reference to establish a prima facie case of anticipation under 35 U.S.C. 102 (b), since Adoma does not disclose, teach, or suggest "**a plurality of flexible fingers disposed in a first circle on said second surface.**" Therefore, Applicant, for this second reason, believes Adoma does not anticipate Applicant's claimed invention.

Accordingly, Applicant believes that Examiner's rejection under 35 U.S.C. 102(b) as being anticipated by Adoma is improper and Examiner has failed to state a prima facie case for anticipation.

Applicant's claims 1, 2 and 13 have been twice rejected under U.S.C. 103(a) as being unpatentable over Adoma.

Issue #3: As stated in the MPEP, the prior art references when combined must teach or suggest all of the claim limitations. Examiner in the final OA of 9/26/2005 on the bottom of page 2 and in Examiner's OA of 3/2/2005 on the top of page 3 states "Adoma may not teach a plurality of fingers disposed in a first circle on said second surface. Adoma teaches on page 5 that clamping device 8 is constructed in a known manner so that the compact disk can be locked in the opening 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to

incorporate a plurality of fingers in the throwable implement of Adoma for the purpose of retaining the compact disc." As noted above, Adoma is an insufficient reference and Examiner's statement above does not cure that insufficiency because Adoma does not disclose, teach, or suggest the possibility of mounting and demounting a compact disc with a plurality of fingers on the second concave surface by the virtue that there is no indication of a clamping retention means in the second concave surface in Adoma. In Applicant's response of 6/1/2005 on the top of page 9, Applicant respectfully requested that Examiner provide an affidavit or cite a particular reference showing the claimed limitations such as the ***plurality of fingers*** disposed on a ***second concave surface*** set forth in Applicant's independent claim 1. However, Examiner has neither provided a reference nor an affidavit. Applicant believes, as with the 102(b) rejection, that Examiner fails to distinguish the convex first surface from the essentially concave second surface as claimed in claim 1. Applicant asserts that clearly Adoma, in combination with Examiner's remarks, is insufficient to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a), since Adoma in combination with Examiner's remarks does not disclose, teach, or suggest ***an essentially concave second surface; and a plurality of flexible fingers disposed in a first circle on said second surface.***

Applicant's claims 1-5 and 13 have been twice rejected under U.S.C. 103(a) as being unpatentable over Adoma in view of Nusselder or Otsuka.

Issue #4: As stated in the MPEP, the prior art references when combined must teach or suggest ***all*** of the claim limitations. From the arguments given above, Adoma is an insufficient reference because Adoma fails to teach or suggest several limitations claimed by Applicant in independent claim 1. In the Examiner's office actions of 3/2/2005 and 9/26/2005, both on the bottom of page 3, the Examiner states "It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of flexible fingers, having the claimed features noted above, as suggested by Nusselder or Otsuka et al. for the clamping retention means of Adoma for the purpose of easily mounting and demounting the compact disc." Applicant's response on 6/1/2005 in the middle of page 9 states that "neither Adoma, nor Adoma in combination with either Nusselder or Otsuka, teach, suggest, or mention the claimed invention." Adoma does not teach, suggest, or mention the claimed

invention by virtue that there is no indication of a clamping retention means in the second concave surface in Adoma. Furthermore, Otsuka is a holder tray for a disk and Nusselder is a storage cassette for disks. Both of these references are silent on a gyroscopically stabilized throwable implement comprising a disk-shaped body having an essentially convex first surface and an essentially **concave second surface** and a **plurality of flexible fingers** disposed in a first circle on said **second surface** and protruding for a predetermined distance away from said second surface. Applicant asserts that clearly Nusselder and Otsuka fail to overcome the deficiencies of Adoma. Thus, Applicant asserts "**an essentially concave second surface; and a plurality of flexible fingers disposed in a first circle on said second surface,**" is not disclosed, taught, or suggested by any of the cited references. Therefore, Applicant believes Adoma, neither by itself nor in combination with Nusselder nor Otsuka is sufficient to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a) and therefore does not render Applicant's claimed invention obvious.

Accordingly, Applicant believes the Examiner's rejection under 35 U.S.C. §103(a) as either being unpatentable over Adoma in view of Examiner's comments or unpatentable over Adoma in view of Nusselder and Otsuka is improper and Examiner has failed to state a *prima facie* case for obviousness.

In addition, although Applicant in this pre-appeal brief request for review has not argued patentability of various limitations in the pending dependent claims, Applicant is not waiving his rights to make such arguments on appeal.

Respectfully submitted,
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